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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,575	01/09/2001	Joerg Kaufmann	59516-216/pp-01656.002	9437

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Chiron Corporation
Intellectual Property R338
P.O. Box 8097
Emeryville, CA 94662-8097

EXAMINER

HARRIS, ALANA M

ART UNIT	PAPER NUMBER
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1643

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/758,575	Applicant(s) KAUFMANN ET AL.	
	Examiner Alana M. Harris, Ph.D.	Art Unit 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-11 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5-11 and 36-38 is/are allowed.
- 6) ☒ Claim(s) 45-47 is/are rejected.
- 7) ☒ Claim(s) 39-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2006 has been entered.

2. Claims 1, 5-11 and 36-47 are pending.

Claims 12-35 have been cancelled.

Claims 1, 5 and 7 have been amended.

Claims 36-47 have been added.

Claims 1, 5-11 and 36-47 are examined on the merits.

Withdrawn Rejections

Claim Rejections - 35 USC § 112

3. The rejection of claims 1 and 5-11 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn in light of Applicants' amendments to the claims.

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4. The rejection of claims 1 and 5-11 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of Applicants' amendments to the claims.

Double Patenting

5. The provisional rejection of claims 1 and 5-11 under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of copending Application No. 10/200,026 (filed July 18, 2002) is withdrawn in light of the cancellation of claims 1-11 in the now issued patent 7,081,517, issued June 26, 2006.

New Grounds of Objection and Rejection

Claim Objections

6. Claims 39, 45 and 46 are objected to because of the following informalities:

- a. Claim 39 ends the claim with two periods;
- b. Claims 45 and 46 reference polypeptides, SEQ ID NO: 10 and 3, respectively and depend from claims 5, 36 and 39. The latter claims reference SEQ ID NO: 2, which includes sequences, SEQ ID NO: 10 and 3. Consequently, claims 45 and 46 are not further limiting from claims 5, 36 and 39. Correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claim 47 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **THIS IS A NEW MATTER REJECTION.**

Claim 47 has been added to the claim set with the submission of the Request for Continued Examination (filed December 18, 2006). Applicants allege support for this claim is found in the pages and lines set forth on page 6 of the Remarks, see 2nd paragraph. The Examiner has reviewed the specification and the specific sites listed by Applicants and does not note support for nucleotides 46-1173 of SEQ ID NO: 1 and the limitation of unchanged with respect to SEQ ID NO: 1. Applicants should delete the new matter or point out support for claim 47.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 45 and 46 are vague and indefinite because they reference polypeptides, SEQ ID NO: 10 and SEQ ID NO: 3, respectively and these claims read on claims 5, 36 and 39. SEQ ID NO: 10 consists of 10 amino acids and SEQ ID NO: 3 consists of 30 amino acid.

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b. Claim 47 recites "...nucleotides at positions *corresponding* to nucleotides 46-1173 of SEQ ID NO: 1...". It is not clear how Applicants intend for the first cited nucleotides to be equivalent to nucleotides 46-1173 of SEQ ID NO: 1. For instance, should the nucleotides be structurally, functionally equivalent to those of SEQ ID NO: 1? Applicants are requested to clarify.

Allowable Subject Matter

11. Claims 1, 5-11, 36-38 are allowed.

12. Claims 40-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571)272-0831. The Examiner works a flexible schedule, however she can normally be reached between the hours of 7:30 am to 6:30 pm, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALANA M. HARRIS, PH.D.
PRIMARY EXAMINER


Alana M. Harris, Ph.D.
27 February 2007